

Application Serial No. 10/620,038
Reply to Office Action dated March 7, 2006

REMARKS/ARGUMENTS

Initially, the Applicants would like to thank the Examiner for the thorough review of the application as filed. The restriction election made in this case is acknowledge and, given that the Examiner has not withdrawn the same in connection with preparing the Office Action, withdrawn claims 41-78 have been canceled (please note that page 2 of the Office Action incorrectly references claims 40-79). Of course, the Applicants reserve the right to file a divisional application on the non-elected subject matter. On page 3 of the Office Action, the Examiner outlines various formal rejections to certain claims under 35 U.S.C. § 112, second paragraph, due to improper dependencies provided. The Examiner graciously reviewed claim 26 as depending from claim 25, claim 30 as depending on claim 29 and claim 31 as depending from claim 30. The Examiner was correct in each instance on these dependencies and the corresponding changes have been made herein. Based on the manner in which claims 26, 30 and 31 have been amended, withdrawal of these formal rejections is requested.

The remaining claims presented in the application, i.e., claims 1-39, currently stand rejected. More specifically, claims 1-36 and 38 currently stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zietlow in view of Igoe (Dictionary of Food Ingredients, 4th Edition). Claims 37 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Zietlow in view of Igoe and further in view of Gajewski. In essence, the Examiner argues that the claims presented in the present application simply represent the product of Zietlow modified by known ingredients and therefore hold the combinations as obvious. Thus, having found references which teach each of the individual ingredients presented in the claims, the Examiner holds that it would have been obvious to one of ordinary skill in the art to make the food product as specifically claimed. These rejections are respectfully traversed for the reasons set forth below.

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The Applicant respectfully submits that the Examiner has not set forth a proper prima facie case of obviousness. That is, the Applicant submits that the Examiner is simply combining references in the prior art which contain individual ingredients presented in the claims of the present application without any motivation to combine the ingredients as claimed. More specifically, although the Office Action refers to the product of Zietlow as a "dried soft aerated confection" (emphasis added) on both pages 4 and 5, the Examiner clearly recognizes on page 6 that Zietlow lacks a softening agent and the affects of the softening agent. Initially, the contrary positions taken are seen to be unclear. Regardless, the Examiner then goes on to cite Igoe in showing that using softening agents in marshmallows is known. The Examiner need not have gone beyond the present application disclosure for this point. But the question which remains is why one of ordinary skill in the art would look to modify the dried aerated confections of Zietlow to be soft in accordance with the present invention. The mere fact that soft marshmallows are known in the art does not provide any motivation for the combination. Basically, the Examiner appears to be stating that adding an ingredient for its known purpose would have been obvious to one of ordinary skill in the art. This position is not supported by existing case law. For example, the U.S. Courts of Customs and Patent Appeals stated that a patentable invention, within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (*In re Spinnable* 56 CCPA 823) (emphasis added). The fact remains that the art must provide the proper motivation for the combination, rather than the combination being just considered obvious by the Examiner who is well beyond one of ordinary skill in the art.

Moreover, the Applicant submits that the Examiner recognizes the deficiencies in Zietlow, at least with respect to the inclusion of any softening agent, the affects of the softening agent, the specifically claimed water activity and a couple other aspects as listed on page 6 of the Office Action. The Examiner then cites Igoe to provide a dictionary definition of certain ingredient terms and holds the combination as obvious to one of ordinary skill in the art because "Igoe teaches that glycerin keeps food from drying

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out and moisture migration into cereals.” But there is no food drying out problem or moisture migration issue in Zietlow, so why modify Zietlow for this purpose? Simply stated, the confection portion in Zietlow is not soft in a manner corresponding to the food product of the present invention and does not have moisture migration problems. Therefore, the motivation for the combination has only come from the Examiner and not the prior art such that a proper prima facie case of obviousness has not been established.

The Applicant would like to emphasize that the test for patentability under 35 U.S.C. §103 is basically whether the differences between the claimed subject matter, considered as the whole, and the prior art would have been obvious at the time the invention was made. Reaching this determination, the skill and content of the prior art, the differences between the prior art and the claimed subject matter and the level of ordinary skill in the art must be considered, along with the relevant secondary issues. *Graham v. John Deere Co.*, 381 U.S. 1, 148 USPQ 459 (1966).

A proper rejection under 35 U.S.C. §103 cannot be based on hindsight knowledge of the invention under consideration for the sole basis of attempting to meet the recitations of the claims. Specifically, the CAFC in *Environmental Designs, Ltd. v. Union Oil Co. of Cal.* 218 USPQ 865, 870 (1983) stated:

All the pieces of the present invention were known in the art, ... That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is, however, simply irrelevant (emphasis added). Virtually all inventions are combinations and virtually all are combinations of old elements. A court must consider what the prior art as a whole would have suggested to one skilled in the art (Case citations).

In the art of food sciences, there is a set list of ingredients approved by the FDA for human consumption. All food products contain one or more ingredients from that list. In short, inventors are limited to their choice of ingredients to combine to produce novel

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food products. In the present situation, an aerated confection food product is dried, but soft, with particular structural characteristics which include a particular water activity range and sufficient amounts of a softening agent to provide a specified glass transition temperature. All of the ingredients used to make the food product of the invention are on the list of FDA approved ingredients. However, this just indicates that pieces of the present invention were known, which is irrelevant as none of the prior art discloses or suggests the combination. Again, the Examiner appears to hold that the combination is obvious simply because all the pieces of the invention are known. As set forth above, the courts have already ruled against taking such a position. Moreover, if a manufacturer wishes to produce a product that will meet with FDA approval, all the ingredients must be on the list of FDA approved ingredients. That is, existing food items are combinations of known ingredients. It is the combination, processing and final product that form the invention. What is the motivation to modify Zietlow at all? Without a motivational teaching in the art to combine the known ingredients in the manner specifically claimed, the Applicant respectfully submits that the Examiner has not satisfied her burden of establishing a prima facie case of obviousness.

Further, the CAFC in *In re Gordon*, 221, USPQ 1125, 1127 (1984) stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. (Case citations.)

Furthermore, the CAFC in *American Hoist & Derrick Co., v. Sowa & Sons, Inc.*, 220 USPQ 763, 771 (1984) quoted:

A patentable invention... may result even if the inventor has in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use. (Emphasis added.)

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Along these lines, references must be evaluated by ascertaining the facts fairly disclosed therein as a whole. It is impermissible to first ascertain factually what [applicant] did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct applicant's invention from such prior art. *In re Shuman and Meinhardt*, 150 USPQ 54 (CCPA 1966). In the present situation, the invention addresses the making of a soft, dried aerated confection food product. It is respectfully improper to combine the prior art, which does not equally address these concerns, to arrive at the inventive solution, by simply piecing together ingredients from various references. As a whole, Zietlow is not concerned with a dried soft aerated confection food product. As a whole, Igoe is also not concerned with a dried soft aerated confection food product. Simply stated, neither Zietlow nor Igoe suggest making a dried soft aerated confection food product and it is not permissible for the suggestion of the combination to simply come from the Examiner for a proper prima facie case of obviousness. That is, it is clear that it is the PTO that has to establish a prima facie case of obviousness and "obvious can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentives supporting the combination." *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and *Ray Geiger*, 815 F.2d 686 (Fed. Cir. 1987).

In a similar manner, Gajewski is not concerned with a dried aerated confection food product such that the mere fact that Gajewski teaches a specific Bloom strength for one form of gelatin does not provide the proper motivation to employ that form of gelatin, with that specific Bloom strength, in making the food product of Zietlow. Gajewski talks about making aerated confections that are "crisp" and can be used as blackboard chalk (see abstract and column 10 lines 20-25), as well as being "crunchy" (see column 9, lines 47+). The Examiner has stated that one of ordinary skill in the art would make this combination so as to be "best suited for ready-to-eat cereal applications," but it is instead considered that these disclosures teach away from any soft, dried aerated confection. Therefore, it is respectfully submitted that the individual,

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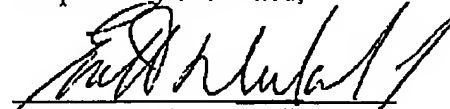
distinct teachings in the art as represented by the applied references do not detract from the inventiveness of the combination set forth in this application.

In addition to distinctions with respect to the broader aspects of the application, it is respectfully submitted that many of the more specific limitations set forth in dependent claims of the application further distinguish the invention from the prior art. For instance, claim 2 sets forth a particular percentage of softening agent, claim 7 provides specific structural aspects in terms of compressibility and returning of the products to an original volume, claim 13 further narrows the limited water activity range of claim 1, claims 21 and 22 set forth specific embodiments where the dried soft aerated food product takes the form of a topical coating or filling, and claim 32 provides a particular springback limitation. As far as could be ascertained from the known prior art, none of these specific limitations are taught in connection with a dried soft aerated confection analogous to the invention and there is no motivation to set forth in even attempting to duplicate these characteristics based on the known prior art. The rejection of claim 6 is particularly troublesome as the Examiner is holding that any known structuring agent can be employed depending on cost. Again, it is not a matter of whether a particular ingredient, e.g., structuring agent, is known, but why one of ordinary skill in the art would depart from the teachings in Zietlow to arrive at the present invention. If a lower cost can be the entire motivation, can the Applicant assume that the Examiner would also find a higher cost be a teaching of non-obviousness? Claims 80-82 have been added to set forth even further details of the springback and bulk compression aspects of the invention. Support for these claims can be found in the original specification, such as on page 14.

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Based on the above, it is respectfully requested that both the formal and prior art rejections be withdrawn, the claims allowed and the application passed to issue. If the Examiner should have any additional concerns regarding the allowance of the application that can be readily addressed, she is cordially invited to contact the undersigned at the number provided below in order to further expedite the prosecution.

Respectfully submitted,



Everett G. Diederiks, Jr.
Attorney for Applicant
Reg. No. 33,323

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DIEDERIKS & WHITE LAW, PLC
12471 Dillingham Square, #301
Woodbridge, VA 22192
Tel: (703) 583-8300
Fax: (703) 583-8301